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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 14

Application Number: 09/494,011
Filing Date: January 28, 2000
Appellant(s): SLATER ET AL.

David A. Novais
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 19, 2002.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-33, 38 and 40.

Claim 34 which appears in the Appendix to the Appeal Brief was canceled in the Amendment filed September 19, 2002, paper no. 11.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on September 19, 2002 has been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1, 2 and 4-14 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

Appellant's brief includes a statement that claims 3, 33, 38 and 40 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

The rejection of claims 15-28 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 29-32 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

A substantially correct copy of appealed claims 1-33, 38 and 40 appears on pages 9-20 of the Appendix to the appellant's brief. The minor errors are as follows: Claim 34 on page 18 of the Appendix was canceled by the Amendment filed September 19, 2002, paper no. 11.

(9) Prior Art of Record

6,157,459	SHIOTA et al.	12-2000
5,218,455	KRISTY	6-1993

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 15-33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art

that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims have been amended to include that each image is related to multiple customer orders. The original specification, claims and drawings disclose that each image is related to a single customer, see page 6, lines 11-12 of the specification.

Claims 38 and 40 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Shiota et al. Shiota et al disclose a photofinishing lab including a plurality of image obtaining devices (the scanner and the digital camera input devices), a plurality of output devices (the printer, the MO disc drive and the ZIP disc drive), associating each image with ID data (col. 4, lines 30, 31 and 49-58), creating batches from multiple orders in the buffers (col. 5, lines 18-29), providing a product from the output devices in part based on a time necessary to complete the images (col. 4, lines 56-58 and col. 6, lines 1-4 and 25-30) and combining the image product with related output (col. 5, line 26).

Claims 1-6, 8-19 and 21-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota et al in view of Kristy. Shiota et al disclose a photofinishing lab including a plurality of image obtaining

devices (the scanner and the digital camera input devices), a plurality of output devices (the printer, the MO disc drive and the ZIP disc drive), associating each image with ID data (col. 4, lines 30, 31 and 49-58), creating batches from multiple orders in the buffers (col. 5, lines 18-29), providing a product from the output devices and combining the image product with related output (col. 5, line 26). Shiota et al do not disclose optimizing the images in a central processing unit. Kristy discloses a photofinishing system including optimizing the images in processor 14, see col. 5, lines 25-33. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Kristy to provide the system of Shiota et al with a processor to optimize the images.

Claims 7 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota et al in view of Kristy as applied to claim 1 above. Further, merely calling for magnetic data to be written on the film would involve only a notorious expedient to one of ordinary skill in the art.

(11) Response to Argument

The appellants argue that the rejection under 35 USC 112 first paragraph is improper because the specification and claim 15 disclose that each batch contains images from multiple customer orders.

The examiner notes that claim 15 was amended on March 14, 2002, paper no. 6, to include the limitations: "...each of said digital images being related to multiple customer orders". Indeed, it was this amendment that prompted the rejection under 35 USC 112 first paragraph. Therefore, clearly claim 15 cannot be relied upon to show that the appellants had possession of the claimed invention at the time the application was filed. The appellants' argument that pages 10 and 11 disclose that batches included images from multiple customers is not persuasive because claims 15-33 claim that each image, not each batch, is related to multiple customer orders. Page 10, lines 29-31 of the specification clearly states that each image has a unique consumer/retailer number. If each image were related to multiple customers, how would developed images get back to the right customers?

The appellants argue re claim 15 that Shiota et al does not disclose a processing unit that is adapted to analyze each of the obtained images for image correction based on at least reference image data.

It is the examiner's position that Shiota et al disclose image processing particularly in col. 1, lines 13-17 but generally throughout the whole disclosure. The apparatus of Shiota et al accepts image data in multiple formats, processes the images and outputs the processed images in multiple formats, not necessarily the same format in which they were received. Changing the image data from one format to another format requires processing to make the image suitable for the new format. Changing the image data from any one of multiple formats to any one of other multiple formats as is done in Shiota et al would require quite sophisticated processing. Surely, such sophisticated processing is adapted to perform the particular processing that appellants' claim 15 calls for.

The appellants argue re claim 40 that Shiota et al do not disclose creating a virtual batch based on at least a time necessary to complete

an output image product and comparing the images to reference image data representative of an optimum image to permit manipulation of the received images based on the reference image data.

It is the examiner's position that Shiota et al disclose providing a product from the output devices in part based on a time necessary to complete the images in col. 4, lines 56-58 and col. 6, lines 1-4 and 25-30. Further, it is the examiner's position that many customers upon receipt of their developed images compare these images to their own concept of an optimum image and if not satisfied ask for the process to be redone.

The appellants argue re claims 1-33 that Shiota et al does not optimize the images and that Christy does not form virtual batches.

The examiner is relying on Shiota et al to teach forming virtual batches and on Christy to teach optimizing images. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The appellants argue that the combination of Shiota et al and Christy does not show a single central processing unit that both makes virtual batches and optimizes the images.

It is the examiner's position that in a combination of Shiota et al and Christy as proposed in the rejections an interconnected device would be operating to create virtual batches and optimize the images, that interconnected device would comprise a single central processing unit.

The appellants argue re claims 16 and 33 that the images are modified in accordance with product/service data and in accordance with the output device to which the images are sent.

It is the examiner's position that the image data in Shiota et al is processed in accordance with the appropriate product/service data and in accordance with the selected output device or else the processing won't work. It must be presumed that the patent reference is operable.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

fjb
October 30, 2002

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